

REMARKS

The Examiner cited several prior art references in the section 102 and 103 rejections.

Although the amendments likely render some of these points moot, the Applicant will discuss these prior art references in the following in order to point out the novel and nonobvious aspects of the invention as presently claimed.

I. Rejections Under 35 U.S.C. §102(b)

Claims 1 and 2 were rejected under 35 U.S.C. §102(b) on the basis of U.S. Patent No. 5,782,447 to Hoffend (1998). In order for a section 102(b) reference to be valid as prior art, every element and limitation of the claimed present invention - as literally defined in the claims - must be disclosed within the piece of prior art. *Jamesbury Corp. v. Litton Indus. Products*, 756 F.2d 1556, 225 USPQ 253 (Fed.Cir. 1985); *Atlas Powder Company v. du Pont*, 750 F.2d 1569 (Fed.Cir. 1984); *American Hospital Supply v. Travenol Labs*, 745 F.2d 1 (Fed.Cir. 1984). The Applicant respectfully submits that this requirement has not been met under the present facts, and that the section 102(b) rejection is therefore improper.

Hoffend's FIG. 1 fully discloses the structure of that invention. It discloses a front wall, a back wall, and a bottom wall (element (20)). The bottom wall fits under the overhanging lip of an above-ground pool, as shown in Hoffend's FIG. 7.

Claims 1 and 2 of the present invention recite a rear wall, a front wall, and a top wall. This top wall fits over the upper surface of the gutter lip. They now contain the specific recitation of an attachment point on the front wall extending outward in a direction away from the rear wall. These elements and limitations are not found in Hoffend. Thus, as amended, claims 1 and 2 are patentable over the prior art.

II. Rejections Under 35 U.S.C. §103(a)

A. The Rejection of Claim 3 Under Hoffend.

Claim 3 depends from claims 1 and 2, which have now been substantively amended. In light of the amendments, the Applicant believes claim 3 to be allowable.

B. The Rejection of Claim 4 Under MacLennan in View of Hoffend.

MacLennan discloses a swimming harness for static exercise in a swimming pool. Hoffend is cited for its disclosure of an attachment bracket. The Applicant respectfully submits that these two references, in combination, fail to disclose key elements of the present invention.

Specifically, claim 4 recites the use of a “flex bow” which is defined as being “... substantially elastic so that as said swimmer exerts swimming force said first and second ends of said flex bow will deflect substantially toward said swimmer.” The importance of this feature is described in the original disclosure (including the disclosure of prior U.S. Patent No. 6,251,049 to Milton, which was explicitly incorporated by reference at Page 2, Lines 7-9). The use of the flex bow allows the swimmer to move forward in the water and thereby obtain feedback as to the amount of force he or she is exerting on the restraining device.

McClellan discloses a bar-like device (element (14) in FIG. 4). However, this element is not defined as elastic. Further, the present claim’s limitation that the flex bow be constrained behind the front wall of the anchor bracket is neither disclosed nor suggested by any combination of the cited references.

C. The Rejection of Claim 5 Under MacLennan, Hoffend, and Milton.

Claim 5 has been amended to refer to claim 4 (rather than claim 6 as was initially recited in error). The Examiner cited the prior patent to Milton as disclosing a bow capable of undergoing substantial elastic deformation. The flex bow disclosed in the prior patent to Milton (the same

inventor as the present inventor) is indeed capable of substantial elastic deformation. In light of the amendments to claim 4, claim 5 is believed to be patentable. However, in the event that the Examiner has remaining concerns regarding claim 5 (on the basis of the Applicant's own prior patent), then the Applicant will offer to submit a terminal disclaimer under 35 U.S.C. §253.

D. The Rejection of Claims 6 and 7 Under McLennan and Hoffend.

Claim 6 recites the combination of a swimming harness with a clamping device which can be attached to a swim gutter on a pool. The Examiner has rejected this claim using the combination of a clamping device which attaches to the outside of a swimming pool for purposes of hanging a towel (Hoffend) with a conventional swimming harness (MacLennan).

The Applicant respectfully submits that the prior art references do not suggest the combination of the present invention. It is axiomatic that the prior art to be considered under section 103 must be analyzed in the absence of any teaching from the claimed invention. Such an evaluation requires the often difficult task of excluding anything taught or suggested by the present invention from one's mind. *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861 (Fed.Cir.1985).

In the abstract, this proposition is straightforward. However, courts have often struggled in applying it to relatively simple inventions. This is true because a relatively simple invention - once revealed by its creator - is easily understood. Thereafter, one is prone "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed.Cir. 983).

The Federal Circuit recently discussed this issue in the case of *In Re Dembiczak*, 175 F.3d 994 (Fed.Cir. 2000), *limited on other grounds by In Re Gartside*, 203 F.3d 1305 (Fed.Cir.2000). *Dembiczak* involved a patent claim on the now-familiar orange trash bags with the printed Jack-

O-Lantern faces.

The Dembiczak patent application was rejected by the U.S.P.T.O., then rejected by the Board of Patent Appeals and Interferences. In reversing these decisions, the Federal Circuit noted that “[T]he best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *Id.* at 999.

The evidence of a suggestion, teaching, or motivation to combine prior art references must be established in order to set forth a *prima facie* case of obviousness. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297 (Fed.Cir.1985). This evidence must come from the prior art references themselves, the knowledge of one who is skilled in the art, or from the suggestions inherent in the nature of a problem to be solved. *ProMold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed.Cir.1996). The suggestion of combination generally comes from the teachings within the references themselves. *In Re Rouffet*, 149 F.3d 1350, 1359 (Fed.Cir.1998).

The Applicant respectfully submits that the requirements for a *prima facie* case of obviousness have not been established in this case. There is no suggestion within Hoffend or MacLennan of the patentable combination recited in claims 6 and 7. Thus, the Applicant contends that claims 6 and 7 are patentable as originally presented.

In view of the above amendments and remarks, the Applicant believes that the claims are in condition for allowance. Accordingly, the Applicant respectfully requests that the Examiner reconsider the rejections.

Respectfully submitted this 14th day of April, 2004.

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